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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/596,806      | 06/19/2000  | Harry J. Buncke      | 540P                | 4594             |

7590 11/30/2004  
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EXAMINER

ODLAND, KATHRYN P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3743

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**REPLY BRIEF NOTED**

The reply brief filed October 5, 2004 has been entered and considered.

Appellant disagrees with certain aspects of the Examiner's Answer, such as the examiner's position about the "Summary of the Invention" stated in the Appeal Brief as well as the examiner's position beginning at page 4.

In response to the arguments regarding the "Summary of the Invention."

Appellant argues, "the examiner's statement regarding new matter is mistaken. Claim 1 near the end of the penultimate paragraph, has this characterization regarding the flexible device as being sufficiently flexible as to avoid movement of the clip applier's tip when the hand operable actuator is moved to apply the force. The examiner had no objection when this wording was added to claim 1 during prosecution of the application, and there was no basis for any such objections..." and proceeds to disagree with the new matter objection regarding the "Summary of the Invention" presented in the Appeal Brief. However, the examiner respectfully disagrees. The limitations of claim 1 are as follows:

*the cable sheath and internal cable being sufficiently flexible so as to avoid movement of the tip when the hand operable actuator is moved to apply said pushing force.*

"The Summary of the Invention" states:

*The flexible cable is not simply something that can be bent or manipulated, it is defined as being sufficiently flexible as to avoid movement of the clip applier's tip when the remote actuator is engaged and moved to apply the force.*

This is clearly different from the claim limitation. Appellant has attempted to add a "special definition" to the term "sufficiently flexible" not provided during prosecution. The term "sufficiently flexible" is a broad term that previously was not given a "special definition" in the specification and it is incorrect to narrow and provide "special definitions" after the close of prosecution.

Further, appellant states, "The Swiggett reference certainly does relate to a different purpose, and does not seek to avoid movement induced by the surgeon's hand, translating through the length of the device to the applier tip."

Firstly, the Swiggett reference given the structure would most certainly avoid movement at the tip given the remote actuation. The cable sheath and internal cable are **sufficiently** flexible as to avoid movement of the tip as claimed. Sufficiently flexible is a broad limitation not given a "special definition." Further, the device, given the remote actuation, will necessarily avoid movement of the tip. Appellant states on page 3 of the Reply Brief, "avoid picking up any movement of the operator's hand at the remote end." However, the claim does not require this limitation. Appellant argues the shaft of Swiggett would not avoid movement at the tip. However, given remote actuation in a reasonably broad interpretation, the actuator can even be operated by another to avoid movement and the distance of the actuator from the tip will most certainly cause an avoidance of movement at the tip since the hand operating the actuator is located at a distance from the handle, thus allowing a more steady grip at the handle. Thus, the device of Swiggett performs the function whether explicitly recited or not.

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Secondly, both the current application specification and that of Swiggett discuss a common goal of solving the problem of "narrow access."

The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO

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